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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/620,479	07/16/2003	Steven G. Johnson	13445-002002	9196
26161	7590	11/16/2005	EXAMINER	
FISH & RICHARDSON PC P.O. BOX 1022 MINNEAPOLIS, MN 55440-1022			CONNELLY CUSHWA, MICHELLE R	
			ART UNIT	PAPER NUMBER
			2874	

DATE MAILED: 11/16/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/620,479

Applicant(s)

JOHNSON ET AL.

Examiner

Michelle R. Connelly-Cushwa

Art Unit

2874

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 20 October 2005.  
2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.  
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1, 63-65 and 73-90 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.  
6) ☒ Claim(s) 1 and 73-88 is/are rejected.  
7) ☒ Claim(s) 63-65, 89 and 90 is/are objected to.  
8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.  
10) ☒ The drawing(s) filed on 16 July 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)  
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.  
4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_.  
5) ☐ Notice of Informal Patent Application (PTO-152)  
6) ☐ Other: \_\_\_\_\_.

## DETAILED ACTION

### ***Continued Examination Under 37 CFR 1.114***

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on October 20, 2005 has been entered.

### ***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

**Claims 1 and 73-88 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 5-8, 13, 14, 16, 19, 21-29 and 42-45 of U.S. Patent No. 6,625,364 B2.** Although the conflicting claims are not identical, they are not patentably distinct from each other because all of the limitations of claims 1 and 73-88 of the present application are at least disclosed or

Art Unit: 2874

suggested in claims 1, 5-8, 13, 14, 16, 19, 21-29 and 41-45 of U.S. Patent No. 6,625,364 B2.

### ***Response to Arguments***

Regarding the rejection to claim 74 under 35 U.S.C. 112, second paragraph, set forth in the previous Office action; the rejection has been withdrawn in view of Applicant's Amendment filed October 20, 2005.

Regarding the rejections to claims 1, 63-65 and 73-90 under 35 U.S.C. 103(a) over Fink et al. (US 6,463,200 B2); the rejections have been withdrawn in view of Applicant's Amendment filed October 20, 2005.

Regarding the rejections to claims 1 and 73-88 under the judicially created doctrine of obviousness-type double patenting over claims 1, 5-8, 13, 14, 16, 19, 21-29 and 42-45 of U.S. Patent No. 6,625,364 B2; the rejection has been maintained. The Examiner notes that Applicant states, "We intend to file a Terminal Disclaimer to obviate the rejection upon an indication that the application is otherwise allowable" in the Remarks section of Applicant's Amendment filed October 20, 2005. After an updated search, the Double Patenting Rejection set forth above is the only remaining rejection to the claims in the present application.

### ***Allowable Subject Matter***

Claims 63-65, 89 and 90 are allowed.

The following is a statement of reasons for the indication of allowable subject matter: The prior art cited on the PTO-892 forms attached to the prior Office actions is

Art Unit: 2874

the most relevant prior art known, however, the invention of claims 63-65, 89 and 90 distinguishes over the prior art of record for the following reasons.

Regarding claims 63-65 and 90; the claims are allowable over the prior art of record because none of the references either alone or in combination disclose or render obvious an all-dielectric waveguide as defined in claim 63, wherein the core has a diameter in a range between about 5 microns and 170 microns and wherein the refractive indices and thickness of at least some of the alternating dielectric layers substantially satisfy the equality set forth in claim 63 in combination with the other limitations of the claim. Claims 64, 65 and 90 depend from claim 63.

Regarding claim 89; the claim is allowable over the prior art of record because none of the references either alone or in combination disclose or render obvious an all-dielectric waveguide as defined in claim 89, wherein a ratio of a refractive index of a high-index one of the two dielectric materials in the dielectric confinement region for the central frequency to that of a low-index one of the two dielectric materials is greater than 1.5 and wherein the refractive indices and thicknesses of at least some of the alternating dielectric layers substantially satisfy the equality set forth in claim 89 in combination with the other limitations of the claim.

Hence, there is no reason or motivation for one of ordinary skill in the art to use the prior art of record to make the invention of claims 63-65, 89 and 90.

### ***Conclusion***

All claims are drawn to the same invention claimed in the application prior to the entry of the submission under 37 CFR 1.114 and could have been finally rejected on the

Art Unit: 2874

grounds and art of record in the next Office action if they had been entered in the application prior to entry under 37 CFR 1.114. Accordingly, **THIS ACTION IS MADE FINAL** even though it is a first action after the filing of a request for continued examination and the submission under 37 CFR 1.114. See MPEP § 706.07(b).

Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning the merits of this communication should be directed to Examiner Michelle R. Connelly-Cushwa at telephone number (571) 272-2345. The examiner can normally be reached 9:00 AM to 7:00 PM, Monday-Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rodney B. Bovernick can be reached on (571) 272-2344. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Any inquiry of a general or clerical nature should be directed to the Technology Center 2800 receptionist at telephone number (571) 272-1562.

Art Unit: 2874

*Michelle R. Connelly-Cushwa*

Michelle R. Connelly-Cushwa

Patent Examiner

November 1, 2005